

### **REMARKS/ARGUMENTS**

Claims 1-7, 9-15, 17, 18, 25-31, 33, 35, 37-39 and 41-52 remain in the application for further prosecution. Claims 1, 25, 48-49 and 51 have been amended.

Claims 1-7, 9-15, 17, 25-31, 33, 35, 37-39, 41 and 43-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,851,010 ("Feinberg") as applied to claims above, and further in view of U.S. Patent No. 6,857,958 ("Osawa").

Claims 18 and 42 were rejected under 35 U.S.C. 103(a) as being unpatentable over Osawa and Feinberg as applied to claims above, and further in view of U.S. Patent No. 6,311,976 ("Duhamel").

#### **I. Feinberg Teaches a "Relatively Simple Gaming Format"**

Feinberg is directed to a simple table game in which the randomly selected event is either a first outcome or a second outcome. Col. 1, lines 4-9. Feinberg does so to even out the odds of the table game between the casino and the player, such that even "novice players" are not "quickly fleeced of their money without receiving any entertainment value often resulting in a lack of repeat customers at casinos." Col. 1, lines 16-19.

The first outcome and second outcome provide a very simple way for the player to determine whether he or she has won. Examples of simple game formats having only a first outcome or a second outcome are provided in Col. 2, lines 38-50, and include

- one or two dice in which the first outcome can be odd numbers and the second outcome can be even numbers such that there is an even probability of getting an odd number or an even number;
- a deck of cards which are broken into odd and even numbers by designating the jack and king odd (the ace can be used, in which case odd cards would outnumber even 7 to 6 or can be designated a no play card);
- a deck of cards in which the first outcome is represented by red cards, and the second outcome is represented by black cards;
- a coin to be flipped, in which the first outcome is a first side of the coin and the second outcome is the second side of the coin.

In essence, each randomly selected outcome is "you win" or "you lose." It's that simple.

Feinberg describes the manner in which the game is played from the bottom of Column 2 into the top of Column 3. In essence, the player pays an initial "fixed cost" to enter the game

and receives a certain “number of decisions.” The player’s goal is to correctly select between the first outcome or the second outcome in each of the “decisions.” During the course of play, the number of the player’s correct selections is tracked. Col. 3, lines 48-54. After the purchased number of decisions has been completed, the player is awarded a payout in accordance with the number of the player’s correct selections.

Notably, the player in Feinberg’s game is not provided with an award after each decision within the number of decisions that the player makes. Nor is Feinberg’s randomly selected outcome (e.g., red/black card, odd/even number, coin flip) selected from a plurality of outcomes that includes a plurality of winning outcomes in which different winning outcomes have different payouts. Nor is Feinberg’s randomly selected outcome indicated by a plurality of individual symbols that form a symbol combination. And, after distinguishing more complicated games like blackjack, craps, roulette, baccarat, and slot machine games (all of which have a plurality of winning outcomes with different payouts) at Column 1, lines 12-24, Feinberg concludes with an additional reason as to why it would be desirable to have a simple table game in which it is easy for the player to determine a win or a loss.

It would also be desirable to provide the possibility of obtaining a large value jackpot for a relatively small opportunity cost in which the player is able to make a decision regarding a number of gaming plays using a relatively simple gaming format, which provides the opportunity to wager on a series of plays at a discounted rate.

(emphasis added) Col. 1, lines 30-34. And, as mentioned above, another of Feinberg’s reasons for this simplistic game is a concern for “novice players” who often get “quickly fleeced of their money” at these more complicated games. Col. 1, lines 16-20.

## **II. Feinberg Does Not Disclose Several Limitations in Amended Independent Claims 1, 25, 48, and 51**

The present invention is exactly the type of wagering game that Feinberg sought to avoid – one that involves a more complex payout structure. To clarify this distinction, Applicants have amended each of independent claims 1, 25, 48, and 51. In short, each of the independent claims includes at least two of the limitations related to (i) a plurality of outcomes including a plurality of winning outcomes, (ii) the plurality of winning outcomes including different winning outcomes having corresponding different ones of the first award, (iii) in response to achieving a

winning outcomes in any one of the plays, providing the player with the first award corresponding to the randomly generated outcome, (iv) outcomes indicated by a symbol combination that is developed from a plurality of individual symbols, and/or (v) awarding a first basic-game award in one of the plays of the basic game and a separate second basic-game award in a different play of the series of plays of the basic game.

None of these claim elements is disclosed in Feinberg. Feinberg fails to disclose a plurality of winning outcomes that are achievable during each play of Feinberg's "number of decisions" involving the player selecting either a first outcome or a second outcome (i.e. there is only two possible outcomes, and at least one is always a losing outcome). Likewise, Feinberg fails to disclose different winning outcomes having different awards. Feinberg also fails to teach providing a first award to player in response to achieving a winning outcomes in any one of the plays within the series of plays. Rather, Feinberg may award a player based on only a total number of correct player selections in all of the plays. Finally, Feinberg does not indicate any outcome by a combination of symbols.

For these reasons, the rejections of independent claims 1, 25, 48, and 51 are respectfully traversed.

### **III. Feinberg Teaches Away From The Claimed Invention**

As mentioned above, Feinberg desires a simplistic game format to the wagering game, one that is easy to use for novice players and involves only a first outcome and a second outcome (e.g., red/black card, odd/even number, coin flip). Quite differently, the present invention not only includes a plurality of outcomes that involve different winning outcomes with different awards in the basic game, but each independent claim calls for an accumulation feature on top of the basic game, which further complicates the wagering game of the present invention. Considering that Feinberg went to great lengths to achieve a simplistic game format and distinguished his simplistic game format from the likes of blackjack, craps, roulette, baccarat, and slot machines in Column 1, lines 12-24, why would the skilled artisan, after reading Feinberg, decide to modify Feinberg by adding all the additional complications of multiple winning outcomes on each play, as well as the accumulation feature to arrive at the present invention? Again, Feinberg sought to keep things simple.

Applicants further note that many of the dependent games relate to the traditional wagering games that Feinberg distinguished in his Background section when describing why he

developed his simplistic game format. See claims 2-3, 18, 26, 41-42. This is yet another aspect of Feinberg teaching away from the present invention.

Because Feinberg teaches away from the present invention, this is yet another reason why the claims are allowable.

#### **IV. Feinberg Teaches Away From The Combination With Osawa**

The Office Action admits that Feinberg lacks the teaching of all the details the accumulation feature that is present in each independent claim. Osawa is relied upon for this aspect of rejecting the claims. As mentioned above, Feinberg desires a simplistic game format to the wagering game – one that is easy to use and fair for all players including “novice players.” If the proposed modification would render Feinberg’s invention unsatisfactory for its intended purpose of providing a simplistic game format, then there can be no suggestion or motivation to make the proposed modification. See MPEP § 2143.01(V). That is the case here. Adding a more complex payout structure to the basic game and a separate accumulation feature is most definitely against Feinberg’s stated objective.

Further, if the proposed modification of Feinberg would change the principle of operation of Feinberg’s invention regarding a simple “you win” or “you lose” game format, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. See MPEP § 2143.01(VI). That is also the case here. Consequently, the Applicants respectfully suggest that the modification of Feinberg to include (i) the more complex basic-game payout structure and (ii) Osawa’s accumulation feature is improper because the references teach away from such a combination. This is yet another independent and distinct reason why the claims are allowable over the proposed combination.

#### **V. The Stated Motivation for the Proposed Combination is Lacking For At Least Two Different Reasons**

In the present application, the stated motivation to combine the references is to employ Osawa’s accumulation feature into Feinberg’s simplistic wagering game so as to “form a block wagering game machine that incorporates an accumulation feature for a secondary game.”

Office Action, p. 4. To establish a *prima facie* case of obviousness, the Examiner must set forth some motivation to combine two references in clear and concise terms. MPEP §§ 706.02, 2142, 2143. The Applicants respectfully suggest that this stated motivation is improper because (i) it lacks any “rational underpinning” to support the rejection since it appears to be based on a faulty reading of Feinberg, and (ii) it simply copies the exact teaching of the present specification as the “motivation” to combine Feinberg and Osawa.

**a. The Stated Motivation Lacks a “Rational Underpinning”**

“There must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006); *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (quoting Federal Circuit statement with approval); MPEP § 2142. In the present case, the underpinning for the stated motivation is “Feinberg [is] directed towards the teaching of starting or granting access to a wagering game with a teaching on the interaction between a basic game and a bonus game.” (*emphasis added*) Office Action, p. 4. While Feinberg teaches a basic wagering game with the simple game format as described above, it is unclear where a bonus game (or the interaction between a bonus game and a basic game) is taught in Feinberg. In fact, the terms “bonus game” and “secondary game” are mentioned nowhere in Feinberg. Because the current obviousness rejection appears to be premised on a faulty reading of Feinberg, the present claims are allowable over Feinberg and Osawa for this reason as well.

**b. The Stated Motivation For Combining Feinberg and Osawa Was Taken Directly From The Applicant’s Own Specification**

The stated motivation to combine Feinberg and Osawa was to “to form a block wagering game machine that incorporated an accumulation feature for a secondary game.” Office Action, p. 4. When considering the quoted statement, it is noteworthy that it fails to recite a reason for

the combination. Rather, it simply recites what the **claimed invention** is – a block wagering game with an accumulation feature. Neither Feinberg nor Osawa mentions the term “block wagering” – that is the Applicant’s terminology. The title of the present application is “Gaming Machines With Block Wagering,” which refers to the concept of a single wager that purchases a series of plays of the wagering game. Hence, the Applicant respectfully suggests that the current rejection may have been based on an impermissible hindsight reconstruction of the claimed invention.

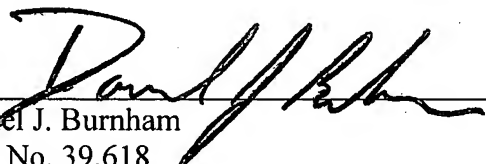
### **Conclusion**

It is the Applicant’s belief that all of the pending claims are in condition for allowance and action towards that end is respectfully requested.

If any matters may be resolved or clarified through a telephone interview, the Examiner is respectfully requested to contact the Applicant’s undersigned attorney at the number shown.

Respectfully submitted,

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